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REMARKS

The Non-Final Office Action mailed September 26, 2008 and the references cited therein have been carefully considered. Claims 1-16 are now pending in the application. By this Response, Claim 2 is hereby amended in order to address the rejection under 35 U.S.C §112, second paragraph as recommended by the Examiner and noted below. Thus, no new matter has been added by amendments to the claims.

Objection to the Specification

Applicants appreciate and acknowledge the typographical error noted by the Examiner in the Office Action at page 10, line 31 with regard to the reference to the optical separation layer. The above amendment to the specification corrects this error. Accordingly, Applicants request entry of the amendment to the specification and withdrawal of the objection thereto.

Claim Rejections under 35 USC § 112

In the Office Action, Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action rejects the way the expression “cover” is used to express the extent of the sealing layer therein. While not acceding to the propriety of this rejection, in order to expedite prosecution Applicants have amended Claim 2 to adopt the Examiner’s interpretation of the original claim. Accordingly, Applicants believe these amendments eliminate the objectionable claim language and therefore request reconsideration and that this rejection be withdrawn.

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Claim Rejections under 35 USC § 103

In the Office Action, Claims 1-5 and 9-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,036,230 to Färber (**Farber**) in view of U.S. Patent Application Publication No. 2005/0153113 to Hsieh et al. (**Hsieh**) and U.S. Patent Application Publication No. U.S. 2005/0104364 to Keller et al. (**Keller**). *It should be noted that although the subject Office Action does not explicitly rejection Claims 6-8 and 14-16, as those claims are included in the explanation of the above rejection in the last paragraph on page 3 and third full paragraph on page 5 of the Office Action, Applicants have assumed for purposes of this Response that the above rejection of the claims under 35 U.S.C. §103(a), applies to all pending claims.* In the Office Action it is argued that the combination of Farber, Hsieh and Keller disclose all the elements of the claims and that it would have been obvious to one of ordinary skill in the art to combine these patent publication to arrive at the claimed invention. Applicants respectfully traverse this rejection. The present invention as defined in the claims is clearly distinguished over Farber, Hsieh and Keller, individually and/or collectively.

An aspect of the present invention relates to a security and/or valuable document including a sealing layer that covers the surface of the film element at least in the region of window-shaped openings. The sealing layer is applied to the side of the support which is in opposite relationship to the film element and the sealing layer is formed from a lacquer layer which is applied by at least one of printing, pouring, sprinkling and spraying. These and other elements distinguish the claimed invention from the cited prior art.

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Farber discloses a security paper that includes a window (2) bridged by a transparent film (3). It is admitted in the Office Action that Farber does not disclose an optical security feature or a sealing layer comprising a lacquer layer. With regard to the absence of a lacquer layer, Farber teaches that the paper or film spanning the window should be transparent in order to clearly distinguish the window in copies and avoid fraudulent reproduction of the security document. Thus, Farber teaches away from using a non-transparent film, such as one containing an image, in that window region. Also, an object of the transparent film (3), as disclosed by Farber, is to span the open window (2) in the security paper. Thus, the transparent film (3) must have sufficient mechanical stability in order to support itself across such an opening. Note Fig. 4 of Farber showing two opposed film elements (3) each self-supported across window (2). Thus, Farber further teaches away from substituting either film element (3) in Fig. 4 with a lacquer, particularly a lacquer layer with a thickness of 2 to 10 μm . A lacquer layer would not have sufficient mechanical stability to support itself across the span of window (2).

Hseih discloses a label laminate whereby an ink layer containing an image can be transferred to a substrate and later removed therefrom. In the Office Action, Hseih is cited for teaching the application of a protective lacquer layer via a screen printing method and it is argued that it would have been obvious to apply such a protective lacquer layer to Farber. In Hseih, a laminate film (61) is disclosed comprising a lacquer layer (63), applied over an ink layer (53), that is supported by a structural layer (55) and an adhesive layer (57). The ink layer (53) contains an image to be transferred to an article and is at the core of the disclosure of Hseih. Also, Hseih specifically discloses that the lacquer (63) is added to protect the ink layer (53) (see,

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Hseih paragraph [0073]). Thus, it is essential that the laminate structure of Hseih include that ink layer (53). In fact, the only reason disclosed in Hseih for adding the protective layer is to protect the ink layer. Thus, it would not have been obvious to one of ordinary skill in the art to substitute the laminate film (61) as taught by Hseih with the film element (3) disclosed in Farber. As noted above, the primary emphasis of the film element (3) in Farber is that it is transparent. The laminate film (61) disclosed in Hseih includes an ink layer, which is not transparent, and is thus not a reasonable substitute for film element (3).

Additionally, assuming arguendo that one did substitute the laminate film (61) for film element (3), the combination would not arrive at the claimed invention. The lacquer (63) is applied to laminate film (61) such that it is not arranged in opposite relationship to the film element, as recited in Claim 1, or disposed on a second side of the support, as recited in Claim 14.

Further, one of ordinary skill would not apply only the lacquer layer (63) as taught by Hseih in place of film element (3) as disclosed by Farber. As noted above, the Farber film element (3) must have sufficient mechanical stability to support itself. Thus, there is no reason to substitute film element (3) with a lacquer layer. The film element (3) of Farber and the lacquer layer (63) of Hseih have completely different functions and are part of completely different laminate applications. There is no reason for one of ordinary skill in the art to apply the protective lacquer of Hseih in the absence of the ink layer it is intended to protect.

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Therefore, the combination of Farber and Hseih fails to teach or reasonably disclose all the limitations of the claims, particularly independent claims 1 and 14. Also, Farber teaches away from using either a laminate film or only a lacquer layer as disclosed by Hseih. Thus, it would not be obvious to one of ordinary skill in the art to combine the disclosures of Farber and Hseih and arrive at the claimed invention.

Keller discloses a security element for security papers having windows. In the Office Action, Keller is cited for teaching a film element 3, which includes an optically variable security feature. However, Keller fails to disclose a sealing layer applied to the side of a paper support which is in opposite relationship to a film element, as recited in Claim 1, or disposed on a second side of the support, as recited in Claim 14. Thus, Keller fails to disclose the combination of elements not taught by Farber and Hseih as addressed above. Further, while Keller discloses additionally security features in the form of printed images (paragraph [0007]), the addition of such would be contrary to the disclosure of Farber that requires a clear transparent layer covering the window. Thus, the combination of Farber, Hseih and Keller fails to teach or reasonably disclose all the limitations of the claims, particularly independent claims 1 and 14. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) based on Farber, Hseih and Keller.

Applicants further submit that the Claims 2-13, 15 and 16, which ultimately depend from Claims 1 and 14 are similarly patentable over the art of record by virtue of their dependence. Also, Applicants submit that claims 2-13, 15 and 16 define patentable subject matter in their own

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right. In view of the foregoing remarks, Applicants respectfully request reconsideration and allowance of the claims presented.

Conclusion

In view of the foregoing remarks, reconsideration and allowance are respectfully solicited. If the Examiner has any questions or suggestions to expedite allowance of this application, she is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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